

### **REMARKS**

The above Amendment and the following Remarks are in timely Reply to the non-final Office Action dated 06/23/03 in this Application. Thirty-four claims (1-34) were pending in this Application. In the above Amendment, Claims 1, 8-16, 18, 20 27 and 28 have been amended. Claims 2 and 7 have been cancelled. Accordingly, 32 claims remain pending in this Application of which claims 1, 18, 27 and 28 are in independent form for reconsideration and further examination. In light of this Reply, the Applicant respectfully requests reconsideration and further examination of this Application.

#### **Objection to Formal Drawings**

Applicant had submitted formal drawings as acknowledged in the Office Action summary. The Examiner checked the block "Objected by the Examiner" on the Office Action Summary (See Item 9). However, no objections have been stated in the office action. Applicant respectfully requests withdrawal of the objection, if the box was checked in error.

#### **Objection to Claim 20**

The Examiner had objected to Claim 20. Applicant has amended Claim 18 to depend from Claim 18, instead of Claim 8. Applicant respectfully requests the withdrawal of the object with respect to Claim 20.

#### **Rejection of Claim 7-16 under 35 U.S.C. § 112**

The Examiner rejected Claims 7-16 as being indefinite and failing to particularly point out and distinctly claim the subject matter. Applicant thanks the Examiner for pointing out the confusion between the "first" and "second" connector, with respect to Claim 7 and 12, respectively. Applicant has incorporated the Examiner's suggestion to replace the "second" connector in claims 8-11 and the "first" connector in claims 12-16. Based on the amendment, Applicant respectfully request withdrawal of the rejection of Claims 7-16 under 35 U.S.C. § 112.

#### **Rejection under 35 U.S.C. § 102**

In paragraph 4, page 3 of the Office Action, the Examiner rejected claims 1, 4-6, 18,25-26, and 28 under 35 U.S.C. 102(b) as being anticipated by Hannah et al. (U.S. Pat. 5,784,581), stating, in pertinent part,

"As to *claim 1*, Hannah teaches a mobile device that can operate both as a host or a device (FIGS 4 and 5) comprising: a processor(controller 44) that can function as a USB controller configured to operate as a USB host or USB device (col. 5, lines 31-52); a housing having an expansion module bay (hub 42)(Fig. 4); an expansion module (camera 54) having a first USB connector (port 58)(Fig. 5); and a second USB connector (hub 42) positioned inside the bay to mate with the

cate through links 59 and 52, depending upon whether VCR 50 is the host or slave. (Col 6, lines 42-51).

Camera 54 of Hannah is not like the expansion module 16 (Figure 3 of the present invention). The expansion module 16 of the present invention include “one or more circuit for providing an expansion module function”, for example a game card, or a modem, or any other functionality. (Specification Page 3, Lines 19-21). This is different than a peripheral device 34 or a camera 54 coupled to the peripheral device.

As stated by the Examiner with respect to Claim 7, Hannah does not disclose “a conversion circuit between the USB interface and the first connector”. (See Page 6, Section 6 of the Office Action, with respect to Claim 7, the limitation of which has been incorporated into Claim 1). The Examiner has relied on Kikinis (US Patent No. 5,841,424) stating that Kikinis teaches “a conversion circuit (USB adapter Fig. 6) coupled between USB devices (col. 5, lines 52-65)”. (Office Action, Page 6, Section 6). First, there is no motivation or suggestion to combine Hannah and Kikinis. Second, assuming arguendo, even if Hannah and Kikinis were combined, the combination will not disclose the elements of amended Claim 1. For example, Kikinis discloses a USB keyboard and the Examiner have compared the expansion module 16 of the present invention with a camera. Neither the camera nor the keyboards fall into this category. Hence, Hannah, and Kikinis (combined) do not disclose or suggest the elements of Claim 1.

The Examiner acknowledges and states:

“Hannah does not explicitly teach the first and second connectors have a form factor smaller than a standard USB form factor”. Ito teaches making the connector smaller in size (col. 2, lines 36-40). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the connectors to have a smaller form factor as taught by Ito in the system of Hannah since today’s portable digital audio equipment is getting smaller in size (col. 2, lines 36-40). (Office Action, Page 5, Paragraph 5, with respect to Claim 2-3 (limitations of Claim 2 are now included in currently amended Claim 1)).

Ito discloses a jack “that is capable of selectively accommodating a first or a second plug, the first plug being used for data communication based on a first data communication standard, the second plug permitting data communication as per a second data communication standard”. (Ito, Abstract). Ito states, as pointed out by the Examiner, “as today’s portable digital audio equipment is getting smaller in size, connections on the equipment also need to be made smaller.

first USB connector when the expansion module is inserted in the bay(Fig. 4 and col. 5, lines 31-52).

In light of the above Amendments to independent claims 1, 18, 27 and 28, and the Remarks that follow, this rejection is respectfully traversed.

Claim 1:

Hannah does not disclose or suggest the elements of currently amended Claim 1. In particular, Hannah does not disclose a “mobile device” in the same context as the present invention and discussed below. Hannah fails to disclose “a Mobile device that can operate both as a host or a device [with] a processor that can function as a USB controller configured to operate as a USB host or a USB device housing having an expansion module bay; an expansion module having a first USB connector; and a second USB connector positioned inside the expansion module bay to mate with the first USB connector when the expansion module is inserted in the bay, wherein the expansion module includes a USB interface and a conversion circuit, which is coupled between the USB interface and the first USB connector; and the first and second USB connectors have a form factor that is different than a standard USB form factor.”[Claim 1]

The Examiner has relied on Hannah’s embodiments disclosed in Figure 4 and 5 of Hannah. Hannah’s peripheral device 34 (Figure 4) is more like a “digital camera or camcorder” (Col. 5, lines 45-46) that can function “either as a USB master or slave”. (Col. 5, lines 32-33). Hannah’s peripheral device 34 intends to provide USB functionality if a computer or host is missing. (Col 1, lines 55-57).

The Examiner has compared the expansion module of the present invention to a “digital camera 54 (Figure 5, Hannah). The Examiner has also compared the expansion module to peripheral device 34 (Office Action, Page 4, with respect to Claim 28). Applicant respectfully traverse the rejection based on the inconsistent comparison and the other reasons set forth below.

Figure 5 shows the interconnections between host controller 10, hub 12, a VCR 50 and a camera 54. (Col 6, Lines 18-20). The configuration shown in FIG. 5 permits VCR 50 communi-

This can promote fragility of the set of portable equipment connectors as opposed to large connectors of stationery type equipment.” (Ito, Col. 2, lines 36-40).

Ito has no relevance to the current invention. Ito merely states the need for smaller connectors in digital audio equipment and provides a jack that can work with two different standards. Applicant does not understand how this impacts USB form factors. Even if Ito was considered relevant, all Ito discloses is a “need for smaller” connectors. That by itself is not enough to disclose “a form factor” different than the USB form factor, as disclosed in amended Claim 1.

USB is a popular standard and commercial products conform to USB standards do not go against the standards. Applicant did not follow the USB form factor, and instead went against the standard.

In light of the foregoing distinctions, it is respectfully submitted that the Examiner’s rejection of claim 1 under 35 U.S.C. 102(b) as being anticipated by Hannah is untenable, and must be withdrawn. Also, any rejection based on the combination of Hannah, Kikinis and Ito under 35 U.S.C. 103 is untenable. Accordingly, withdrawal of Examiner’s rejection of Claim 1 is respectfully requested.

#### Claim 4-6

Claims 4-6 directly or indirectly, depend from Claim 1 and are hence patentable for at least the reasons discussed above for Claim 1. It is respectfully submitted that the Examiner’s rejection of claim 4-6 under 35 U.S.C. 102(b) as being anticipated by Hannah is untenable, and must be withdrawn. Accordingly, withdrawal of Examiner’s rejection of Claims 4-6 is respectfully requested.

#### Claim 18

Claim 18 is patentable over Hannah for at least the reasons discussed above regarding Claim 1. Accordingly, withdrawal of Examiner’s rejection of Claim 18 is respectfully requested.

#### Claim 25-26

Claims 25-26 depend from Claim 18 and are hence patentable for at least the reasons discussed above for Claim 18. It is respectfully submitted that the Examiner’s rejection of claim 25-26 under 35 U.S.C. 102(b) as being anticipated by Hannah is untenable, and must be with-

drawn. Accordingly, withdrawal of Examiner's rejection of Claims 25-26 is respectfully requested.

Claim 28

Claim 28 is patentable over Hannah for at least the reasons discussed above regarding Claim 1. Accordingly, withdrawal of Examiner's rejection of Claim 28 is respectfully requested.

**Rejection under 35 U.S.C. § 103**

In paragraph 5, page 5, the Examiner rejected Claims 2-3, 19 and 29 under 35 USC § 103(a) as being unpatentable over Hannah as applied to Claim 1, 18 and 28 and further in view of Ito. In light of the above Amendments to independent claims 1, 18, 27 and 28, and the Remarks that follow, this rejection is respectfully traversed.

Claim 2

This claim has been cancelled and incorporated in amended Claim 1.

Claim 3

Claim 3 depends from Claim 1 and is hence patentable for at least the reasons discussed above for Claim 1. It is respectfully submitted that the Examiner's rejection of claim 1 under 35 U.S.C. 103(a) as being anticipated by Hannah and Ito is untenable, and must be withdrawn. Accordingly, withdrawal of Examiner's rejection of Claim 3 is respectfully requested.

Claim 19

Claims 19 depends from Claim 18 and is hence patentable for at least the reasons discussed above for Claim 18. It is respectfully submitted that the Examiner's rejection of claim 18 under 35 U.S.C. 103(a) as being anticipated by Hannah and Ito is untenable, and must be withdrawn. Accordingly, withdrawal of Examiner's rejection of Claim 19 is respectfully requested.

Claim 29

Claim 29 depends from Claim 28 and is hence patentable for at least the reasons discussed above for Claim 28. It is respectfully submitted that the Examiner's rejection of claim 28

under 35 U.S.C. 103(a) as being anticipated by Hannah and Ito is untenable, and must be withdrawn. Accordingly, withdrawal of Examiner's rejection of Claim 29 is respectfully requested.

In paragraph 6, page 6, Claims 7-17, 20-34 and 30-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hannah as applied to Claim 1, 18 and 28 and further in view of Kikinis.

Claim 7

This claim has been cancelled and the limitations are now in Claim 1.

Claim 8-17

Claims 8-17 depend from Claim 1 (directly or indirectly) and are hence patentable for at least the reasons discussed above for Claim 1. It is respectfully submitted that the Examiner's rejection of claims 8-17 under 35 U.S.C. 103(a) as being anticipated by Hannah and Kikinis is untenable, and must be withdrawn. Accordingly, withdrawal of Examiner's rejection of Claims 25-26 is respectfully requested.

Claims 20-24

Claims 20-24 depend from Claim 18 (directly or indirectly) and are hence patentable for at least the reasons discussed above for Claim 18. It is respectfully submitted that the Examiner's rejection of claims 20-24 under 35 U.S.C. 103(a) as being anticipated by Hannah and Kikinis is untenable, and must be withdrawn. Accordingly, withdrawal of Examiner's rejection of Claims 20-24 is respectfully requested.

Claims 30-34

Claims 30-34 depend from Claim 28 (directly or indirectly) and are hence patentable for at least the reasons discussed above for Claim 28. It is respectfully submitted that the Examiner's rejection of claims 30-34 under 35 U.S.C. 103(a) as being anticipated by Hannah and Kikinis is untenable, and must be withdrawn. Accordingly, withdrawal of Examiner's rejection of Claims 30-34 is respectfully requested.

### Claim 27

Claim 27 is rejected under Kikinis in view of Hannah (Page 9, paragraph 7 of the Office Action). The Examiner has compared the "keyboard" of Kikinis with the personal digital assistant of amended Claim 27. Kikinis discloses "a keyboard with Universal Bus protocol" with "multiple bays with physical engagement interfaces and electrical connectors for supporting serial-compatible peripheral devices. (Kikinis, Abstract). Kikinis provides bays 19a-19d "to accept special adapters for the purpose of stationing peripherals on keyboard 11. (Kikinis, col. 3, lines 9-10). The Examiner has compared the mobile personal digital assistant of Claim 1 of the present invention to a personal computer with a keyboard. A personal computer as used in Kikinis and in general, is not a mobile device.

Claim 27 is patentable over Kikinis and Hannah for at least the reasons discussed above and also with respect to the reasons given above regarding Claim 1. Accordingly, withdrawal of Examiner's rejection of Claim 27 is respectfully requested.

### CONCLUSION

For the foregoing reasons, Applicant believes Claims 1, 3-6, 8-34 are allowable, and a notice of allowance is respectfully requested. If the Examiner has any questions regarding the application, the Examiner is invited to call the undersigned Attorney at (949) 955-1920.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Assistant Commissioner for Patents, PO Box 1450, Alexandria, VA 22231-1450 on 9/22/03.



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Date of Signature 9/22/03